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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,334	01/03/2000	MAKOTO SAITO	990696A	7676

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EXAMINER
HAYES, JOHN W

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/476,334	SAITO, MAKOTO
	Examiner	Art Unit
	John W Hayes	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *71-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *71-80* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 May 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *18* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 71, 73 and 74 in the response filed 14 January 2003. Thus, claims 71-80 are the only claims remaining in the application and are again presented for examination.

Terminal Disclaimer

2. The terminal disclaimer filed on 11 October 2001 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,069,952 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

3. Applicant's arguments with respect to claims 71-80 have been considered but are moot in view of the new ground(s) of rejection.

4. With respect to the double patenting rejection, applicant contends that the present claims 71-72 and claim 1 of U.S. Patent No. 6,128,605 do not recite the same function. Examiner submits, however, that claim 1 of U.S. Patent No. 6,128,605 at least recites the limitations of present claims 71-72 such that data is encrypted with a first key, decrypted the data using the first key, displaying the decrypted data, re-encrypting the data using a second key and storing, copying or transferring on the re-encrypted data. Examiner also submits that it would have been obvious to one having ordinary skill in the art to remove other limitations recited claim 1 of U.S. Patent No. 6,128,605 and arrive at claims 71-72 in the present case since these functions are similar in both sets of claims. Thus, examiner is maintaining the double patenting rejection.

Drawings

5. The corrected or substitute drawings were received on 31 May 2002. These drawings are approved by the examiner.

Claim Objections

6. Claim 71 is objected to because of the following informalities: In the amendment filed 14 January 2003, the clean version of claim 71 and the marked-up version of claim 71 do not match. Examiner requests that applicant review all the claims to ensure that the clean version matches the marked-up version. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 71-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choudhury et al, U.S. Patent No. 5,509,074 in view of Butter et al, U.S. Patent No. 5,381,480 and Atalla, U.S. Patent No. 4,588,991.

As per claims 71-80, Choudhury et al disclose a method of protecting electronically published materials using cryptographic protocols and teaches a method of encrypting unencrypted data using a first secret key (Col. 2, lines 59-61; Col. 4, lines 1-26), supplying the encrypted data to a primary user and decrypting the encrypted data using the first secret key (Col. 2, lines 60-64; Col. 4, lines 1-26), displaying the decrypted data (Col. 2, lines 60-64; Col. 4, lines 1-26). Choudhury et al, however, fail to specifically disclose re-encrypting the decrypted data using a second secret-key and handling storing, copying and transferring the re-encrypted data and not the decrypted data. Butter et al disclose a system for translating encrypted data and further disclose encrypting unencrypted data using a first secret key (Col. 1, lines 10-13 and 47-53; Col. 2, lines 27-31; Col. 3, lines 1-8; Col. 4, lines 10-15), decrypting the data using the first secret key (Col. 1, lines 15-20 and 59-64; Col. 2, lines 7-10 and 30-37; Col. 4, lines 19-23)

and re-encrypting the decrypted data using a second secret key and transferring the re-encrypted data and not the decrypted data (Col. 1, lines 19-27; Col. 2, lines 37-53; Col. 3, lines 4-8; Col. 4, lines 27-34). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Choudhury et al et al and include the capability to re-encrypt the decrypted data with a second secret-key and then transfer the re-encrypted data as taught by Butter et al. Butter et al provides motivation by indicating that in some cases, data must be transmitted from a second site to a third site which does not have the same secret key, but a different secret key and that it is sometimes necessary to translate the data using a second secret key that the third site has access to. Thus, information could be encrypted by a first site using a first secret key, decrypted by a second site using the first secret key and further re-encrypted by the second site using the a second secret-key used by the third site.

Atalla disclose a file access security method and teach encrypting data using a first key (Col. 2, lines 35-42), accessing or displaying the data by decrypting the data using the first key (Col. 2, lines 57-65), editing the data and then transferring the data back into storage in encrypted form using a second key (Col. 2, lines 57-65). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Choudhury et al and include handling storing, copying and transferring operations on the copyrighted data using the re-encrypted data and not the decrypted data as taught by Atalla. McCarty provides motivation by indicating that this method would prevent substitutions or outdated files once a file is accessed, even merely for display without alteration, so that a file one accessed, and therefore with its security compromised, can be re-secured against duplication, substitution and re-use (Col. 1, lines 30-35).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the

conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 71-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,128,605.

As per Claims 71-72, Claim 1 of U.S. Patent No. 6,128,605 recites all the limitations of these claims. Claim 1 of U.S. Patent No. 6,128,605 differs since it is an apparatus claim rather than a method claim and further recites additional claim limitations including the elements that make up the system. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 6,128,605 by removing certain limitations directed to the elements that make up an apparatus and other functional limitations resulting in a method claim such as that of claims 71-72 since claim 1 of U.S. Patent No. 6,128,605 performs essentially the same function as claims 71-72 plus additional functions. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Conclusion

11. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Klonowski discloses a method and apparatus for encrypted communication in data networks and teaches encrypting messages from an originating node to a destination node using one key and further wherein the destination node decrypts the message and then re-encrypts the message with a different key
- Hamilton et al disclose a method and apparatus for controlling access to digital signals and teach encrypting signals over a first communication path using a first encryption scheme and further decrypting

the signals and transmitting the signals over a second communication path using a second encryption scheme.

- Grundy discloses a method and system for decentralized manufacture of copy-controlled software
- Halter et al disclose a method and system for securely distributing a plurality of software files from a distributor to a user
- Nagahama discloses the use of encryption techniques for licensing to use software products that are sold on a piece by piece basis
- Newell discloses a system for preventing unauthorized copying of recorded information
- Matyas et al [EP 0191162 A2] disclose a method of software protection wherein encryption keys are used so that software can be run only on designated computers or by users possessing a designated smart card.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

John W. Hayes
Primary Examiner
Art Unit 3621

March 27, 2003